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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,711	02/12/2004	Mrugesh Shah	HO-P03493US0	3444
26271	7590	07/31/2009		
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SUITE 5100				
HOUSTON, TX 77010-3095				
EXAMINER				
STAPLES, MARK				
ART UNIT		PAPER NUMBER		
1637				
NOTIFICATION DATE		DELIVERY MODE		
07/31/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/776,711

Applicant(s)

SHAH, MRUGESH

Examiner

MARK STAPLES

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,9,11-15,17 and 18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637

Continuation of 11, does NOT place the application in condition for allowance because:

Claim 16 has been canceled in the amendment filed 07/17/2009 which is entered. As claim 16 is canceled, the rejections and objections to claim 16 are moot and therefore are withdrawn. It is noted that Applicant presents arguments regarding canceled claim 16 but as claim 16 is canceled, these arguments are also moot.

The pending claims remain rejected as follows

The rejection of claims 1, 3, 9, 11-15, 17, and 18 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is maintained. Applicant's arguments filed 07/17/2009 have been considered but they are not persuasive.

The cited Reference is not considered.

Applicant's arguments with respect to the cited reference by James G. Speight are not considered here, as the cited reference or relevant portions thereof have not been submitted in a proper Information Disclosure Statement (see Improper Information Disclosure below).

Applicant conveys that Examiner alleges that the instant specification has no guidance as to how one would identify genes within a differentially enriched DNA pool, the expression of which contributes to biosynthetic petroleum. This is not correct. Firstly, Examiner has conveyed a key and omitted qualification in this argument which is that the instant specification does not provide guidance to identify the gene or genes of instant claims for conversion of recited substances into biosynthetic coal or biosynthetic petroleum. Secondly, the limitation of "contribute" is not recited in the instant claims and Examiner has not addressed this limitation, and does not do so now as it is not found in the instant claims.

Although, the following argument was in view of the cited reference which is not considered, Applicant generally argues that the state of the art was that petroleum analytical work was sufficiently developed at the time of the instant priority date to be able to be done without undue experimentation. For this to be considered and possibly acknowledged, Applicant should properly submit evidence supporting this for review by Examiner. Furthermore, petroleum itself is not directly at issue in the claims as it is not the result of the claimed conversion, as the claims recite biosynthetic petroleum is the result of the claimed methods, from conversion by a gene or genes capable of converting recited substances into biosynthetic petroleum. Due to lack of evidence properly provided and even considering Applicant's arguments without such evidence, the argued petroleum analytical work does not give any support for enablement of the instant claims for converting recited substances by a transfected microorganism into biosynthetic petroleum.

As Applicant has not properly provided evidence to the contrary or persuasive argument otherwise, the instant claims are not enabled and remain rejected.

Improper Information Disclosure

The information disclosure statement filed on 07/17/2009 within Applicant Arguments/Remarks Made in Amendment fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the content requirements as discussed in MPEP § 609.04(a) are not complied with and because copies of non-patent literature have not been provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Mark Staples

/M. S./

Examiner, Art Unit 1637

07/27/2009